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CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Pacific Life Insurance Company

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Serial No. 76276166

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Stacy R. Halpern of Knobbe, Martens, Olson & Bear for  
Pacific Life Insurance Company.

Katherine Stoides, Trademark Examining Attorney, Law Office  
110 (Chris A.F. Pedersen, Managing Attorney).

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Before Hanak, Walters and Holtzman, Administrative Trademark  
Judges.

Opinion by Walters, Administrative Trademark Judge:

Pacific Life Insurance Company has filed an application  
to register the mark shown below on the Principal Register  
for "financial services, namely life insurance and annuities  
underwriting; mutual fund management services, mutual fund  
investment, advisory, distribution, brokerage and  
administration services; mutual fund investment consultation  
services, investment of funds for others; investment

consultation, management, brokerage, and advisory services; investment advice.”<sup>1</sup> The application record includes a disclaimer of FUNDS apart from the mark as a whole.



The Trademark Examining Attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark shown below, previously registered for "mutual fund advisory services,"<sup>2</sup> that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive. The cited registration includes a disclaimer of CAPITAL FUNDS apart from the mark as a whole.



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<sup>1</sup> Serial No. 76276166, filed June 22, 2001, based on an allegation of a bona fide intention to use the mark in commerce. An amendment to allege use with specimens was filed on July 5, 2002, asserting that the mark was first used and used in commerce as least as early as August 15, 2001. The Examining Attorney accepted this amendment.

<sup>2</sup> Registration No. 1,908,769 issued August 1, 1995, in International Class 36. The records of the USPTO show ownership of the registration in Pacific Century Financial Corporation, by change of name from Bancorp Hawaii, Inc. The registration includes the following statement: "The mark includes a triangular design. Color is not claimed as a feature of the mark." [Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We reverse the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We consider, first, the services involved in this case, and we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are.

*Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

The recited services in the cited registration are "mutual fund advisory services," and applicant's recitation of services includes mutual fund advisory services. Thus, these services are, at least in part, identical and applicant does not argue otherwise.

Additionally, applicant concedes in its reply brief (p. 2) that the channels of trade "may be" the same, but contends that the relevant consumers purchase such services only after careful consideration and investigation. Given the broad scope of the recitations of services, we conclude that the trade channels are those normal for these types of services and that the services are offered to all the usual purchasers of such services. Therefore, the channels of trade and purchasers of the respective services are identical. The evidence of record does not address the level of care involved in purchasing applicant's or registrant's services or the sophistication of relevant purchasers. There is no question that choosing mutual fund advisory services involves more than an impulse decision and may involve substantial sums of money, such that a certain

amount of care is likely to be taken in choosing mutual fund advisory services. However, it is reasonable to assume that such services are offered to all consumers and, clearly, the purchasing sophistication of the general public varies substantially. Further, even investment-savvy consumers may be subject to confusion as to the source of the recited services if identified by confusingly similar marks.

We turn, next, to a determination of whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression.

The Examining Attorney contends that the marks have similar commercial impressions because they both contain the term PACIFIC, which the Examining Attorney states is arbitrary in relation to the recited services; that PACIFIC is the dominant portion of each mark; and that registrant's sail design and applicant's whale design each "reinforce the aquatic meaning of the term PACIFIC, thereby augmenting the similarities of the marks" (Brief, unnumbered p. 5). The Examining Attorney argues that, while there may be numerous registrations that include the terms PACIFIC, FUNDS and/or CAPITAL, "a review of the Register results in a finding that the *combination* of PACIFIC and FUNDS is indeed quite strong" (*emphasis in original*) (Brief, unnumbered p. 12).

Applicant contends that the marks are quite distinct, arguing that its whale design is a distinctive and dominant portion of its mark because it is "more conspicuous than the accompanying words" (Brief, p. 7); that both the whale design and PACIFIC portions of its mark are well-known, noting that applicant owns several registrations for marks containing PACIFIC, noted infra, and one registration for the whale design alone<sup>3</sup>; that the whale design "emphasizes and evokes images related to applicant's goals and its philosophy [of] persistence, performance and strength" (Brief, p. 10); that applicant owns two federal copyright registrations for the whale design; that the design element and term CAPITAL distinguish the registered mark from applicant's mark; that the literal portions of the registered mark are weak; that there are numerous third-party registrations for similar marks for similar services and that applicant's mark is less similar to the mark in the cited registration than are several of these third-party marks; that there has been no actual confusion over a period of approximately ten years of coexistence; and that relevant consumers are sophisticated and take care when purchasing the services herein.

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<sup>3</sup> Registration No. 2,520,797, for the whale design for various insurance and investment services.

Applicant submitted a substantial amount of evidence in support of its position in its response of July 2, 2002, and its request for reconsideration of March 4, 2003.<sup>4</sup>

Applicant's counsel stated that applicant was founded in 1868 and has offered a variety of financial products and services since that date; that it began using the mark PACIFIC MUTUAL in 1937 and PACIFIC LIFE in 1997; that applicant is the fifteenth largest life insurance company in the nation; and that, with its affiliates, applicant manages more than \$357 billion in assets and has 81 of the 100 largest U.S. companies as clients.

Applicant submitted a copy of a brochure explaining its company, a press release about its sponsorship of a tennis tournament, excerpts from its Internet web site, a PTO trademark examination guide, third-party registrations for various marks for services similar to those of applicant, and a copy of a consent agreement between applicant and a third-party applicant regarding use and registration of the third-party applicant's mark PACIFICA FUND for investment services. Applicant also submitted copies of its registrations for marks containing PACIFIC for various

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<sup>4</sup> In its request for reconsideration, applicant included an amendment to add the following statement in the application: "Applicant is the owner of U.S. Trademark Registration Nos. 1,309,321; 1,605,912; 1,850,869; 2,098,077; 2,093,489; 2,099,968; 2,168,494; 2,472,077; 2,520,797; 2,605,656; 2,688,066; 2,098,077 and others." This amendment was not addressed by the Examining Attorney in either her denial of reconsideration or in her brief. Thus, the application must be returned to the Examining Attorney for consideration and entry of the amendment as appropriate.

financial and insurance services, arguing that if the marks herein are confusingly similar, then its prior registrations should have prevented issuance of the cited registration.

The following are several examples of applicant's registrations:

REGISTRATION NO.	MARK
2,337,578 & 2,377,472	USE THE POWER OF THE PACIFIC
2,168,494	PACIFIC LIFE
1,309,321	PACIFIC MUTUAL
2,213,338	PACIFIC LIFECORP
1,850,869	PACIFIC MEZZANINE INVESTORS
1,605,912	PACIFIC SELECT
2,310,848	PACIFIC FRONTIERS
2,098,077	PACIFIC PORTFOLIOS
2,422,511	PACIFIC RISK MANAGEMENT SERVICES
2,411,140	PACIFIC VALUE
2,472,077	PACIFIC FINANCIAL PRODUCTS

In support of its contention that it has used the whale design extensively in advertising its services, applicant submitted a copy of an ad from *Advisory Today Magazine*<sup>5</sup> as an example of its national advertising campaigns, copies of its brochures and other promotional materials, a list of

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<sup>5</sup> Applicant indicated that a copy of an ad from *The Wall Street Journal* was submitted, but not such copy is in the record.



television networks showing its advertising, and materials showing its sponsorship of a tennis tournament, Holiday Bowl, golf tournament and AIDS walk.

In its brief (p. 11), applicant argues that several third-party registered marks contain the terms PACIFIC and FUND for the same or closely related services and other third-party registrations contain PACIFIC and CAPITAL for various investment, financial and commercial real estate services<sup>6</sup>; that the previously-mentioned third-party mark, PACIFICA FUND, for which applicant has a consent agreement, has registered; and that, therefore, "even a slight variation in a mark containing the word PACIFIC is all that is necessary to avoid likelihood of confusion" (Brief, p. 12). The Examining Attorney objected to this evidence because applicant did not properly submit copies of these third-party registrations, nor did applicant submit these registrations prior to appeal. However, in the same paragraph in her brief, the Examining Attorney conceded that "applicant is correct in its assertion that there are numerous registrations comprised of the terms PACIFIC, FUNDS and/or CAPITAL" (Brief, unnumbered p. 12). Despite the Examining Attorney's objection, in view of her concession that there are "numerous" third-party registrations for

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<sup>6</sup> The listed marks include EUROPACIFIC GROWTH FUND; THE 59 WALL STREET PACIFIC BASIN EQUITY FUND; CAPITAL PACIFIC HOLDINGS and design; PACIFIC CREST CAPITAL and PACIFIC CREST CAPITAL INC. and design; PRC PACIFIC RIM CAPITAL and PRC PACIFIC RIM CAPITAL INC.

marks containing these terms, we have decided to consider applicant's evidence herein.

In determining the similarities in the marks, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

With respect to applicant's mark, the words and design are approximately the same size and, thus, create equal visual impressions. Auditorily, however, the words clearly predominate as the words will be used to refer to the identified services by name. The word FUNDS is merely descriptive of the object of applicant's advisory services.

The evidence of third-party registrations indicates that PACIFIC has a geographic connotation and, thus, is a weak term with respect to the identified services. PACIFIC is likely to be perceived as suggesting the geographic locus (*i.e.*, Pacific Rim, Pacific Basin, Pacific Crest) of the investments that are the subject of applicant's services.

Therefore, in view of the weakness of the marks herein and the existence of similar marks on the register for the same or similar services, we conclude that this is a case where the design elements of the respective marks are sufficient to distinguish the marks so that the contemporaneous use of applicant's mark and registrant's mark on the same and related services involved in this case is not likely to cause confusion as to the source or sponsorship of such services.<sup>7</sup>

*Decision:* The refusal under Section 2(d) of the Act is reversed.

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<sup>7</sup> Applicant made a number of arguments herein that are not well taken and we are not persuaded thereby. For example, applicant's evidence does not establish fame. There is no evidence of sales or advertising or evidence establishing the nature or extent of consumer awareness of this mark. Moreover, had applicant established that its mark is famous, this would not overcome the refusal because the validity of the cited registration is not at issue herein.

Applicant's allegation that there has been no actual confusion for ten years is of limited value in the context of an *ex parte* appeal. Moreover, the test under Section 2(d) is not actual confusion but likelihood of confusion. See, *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-1027 (TTAB 1984); and *In re General Motors Corp.*, 23 USPQ2d 1465, 1470-1471.

There is no evidence that the whale design would be perceived as connoting anything in particular; nor are its copyright registrations of any significance herein.